

CITED ART SUBJECT TO OBLIGATION OF ASSIGNMENT TO SAME
ASSIGNEE – 35 U.S.C. § 103(c)

Applicant respectfully requests that the Office remove U.S. Patent No. 6,700,933 to Wu as a prior art reference in prosecution of the instant application as a result of the following statement as set forth in the Manual of Patent Examining Procedure, 706.02(I)(2) II.

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the Examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

The instant application and the document, U.S. Patent No. 6,700,933 to Wu, were, at the time the invention of the instant application was made, were each subject to an obligation of assignment to Microsoft Corporation. Applicant respectfully submits that the document, U.S. Patent No. 6,700,933 to Wu, only qualifies as prior art under § 102(e), and that it shared a common assignee with the instant application at the time the subject matter of the instant application was conceived. Thus, U.S. Patent No. 6,700,933 to Wu, which was cited under § 103(a) in combination with U.S. Patent Application Publication 2003/0058931 to Zhang and U.S. Patent Application Publication 2003/0002579 to Radha in rejecting claims 1-5, 7-14, 16-18, and 37 should be disqualified under § 103(c).

REMARKS

Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-14, 16-23, 25-32, and 34-39 are currently pending.

Allowed Claims

The Office Action indicates that claims 19-23, 25-32, 34-36, 38, and 39 are allowed. Without commenting on the Office's reasons for indicating allowable subject matter, Applicant thanks the Examiner for allowing claims 19-23, 25-32, 34-36, 38, and 39. These claims have not been amended herein, and therefore remain in condition for allowance.

In addition, claims 6 and 10 are recognized as containing allowable subject matter, but stand objected to for separate reasons. Without commenting on the Office's reasons for indicating allowable subject matter, Applicant thanks the Examiner for the indication of allowable subject matter in claims 6 and 10.

Specification Objections

The Specification stands objected to for a typographical informality in paragraph [0034]. Applicant amends the specification herein, as shown above, to address the informality noted in the Office Action.

Claim Objections

Claim 6 stands objected to for depending upon a claim that is rejected.

Claim 10 stands objected to as currently pending. However, the Office Action recognizes that claim 10 "would be allowable if the fourth indentation, step (c), were

amended to recite ‘using the encoded base layer bitstream without decoding the encoded base layer bitstream’ rather than ‘while keeping the bitstream of the encoded base layer unchanged’.

Applicant respectfully asserts that the statement under 35 U.S.C. § 103(c) filed herewith renders these objections moot.

Cited Documents

The following documents have been applied to reject one or more claims of the Application:

- **Zhang:** Zhang, U.S. Patent Application Publication No. 2003/0058931
- **Radha:** Radha, U.S. Patent Application Publication No. 2003/0002579
- **Wu:** Wu, U.S. Patent No. 6,700,933.

Claims 1-5, 7-14, 16-18, and 37 are Non-Obvious Over Zhang in view of Radha and further in view of Wu

Claims 1-5, 7-14, 16-18, and 37 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Zhang in view of Radha and further in view of Wu. Applicant respectfully traverses the rejection. Nevertheless, solely in the interest of expediting allowance Applicant herein files a statement under 35 U.S.C. § 103(c) to remove the Wu reference, thereby rendering the rejection moot. Applicant respectfully requests that the Examiner to withdraw the rejection of these claims.

Response to Final Office Action under 37 CFR § 1.116

Applicant respectfully submits Applicant’s statement of Obligation of Assignment to the Same Assignee under 35 U.S.C. § 103(c) should be entered since U.S. Patent No. 6,700,933 Wu was first cited in the pending final action, and since prior art applied

under § 103(a) which only qualifies under § 102(e), (f), or (g) “*shall not preclude patentability*,” (emphasis added, 35 U.S.C. § 103(c)(1)).

Claims 1-5, 7-14, 16-18, and 37 should now be patentable since the best references should already have been applied. see *MPEP*, 706.02(I)(3)) 37 CFR § 1.116(e) provides: “evidence submitted after a final rejection ... may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.”

In accordance with 35 U.S.C. § 103 and 37 CFR § 1.116, assignment of both the reference and the instant application to Microsoft was of record with the filing of the instant application. In addition, the Office noted the common assignment and the possibility of removal of Wu as a reference in the pending Office Action. Thus, the Office should have anticipated that the reference would be removed via § 103(c), (see *MPEP* 706.02(I)(3)). Herein, Applicant timely files the § 103(c) declaration as part of a Response to Final Office Action under 37 CFR § 1.116. Furthermore, until the reference was cited, no statement under 35 U.S.C. § 103(c) was necessary. If the Office does not believe that the claims are patentable, then the Office should bear the burden of reopening prosecution because the reference was first cited in the pending final office action, and the Examiner should have anticipated removal of U.S. Patent No. 6,700,933 Wu under 35 U.S.C. § 103(c).

Applicant appreciates the Examiner’s duty to cite the best art, even if commonly assigned; the Examiner also has a duty to remove that art when a proper declaration is submitted, as in this case. Applicant respectfully asserts that since the claims should now be patentable and Applicant had no reason to know that the Office would cite Wu in

the rejection, entering the § 103(c) declaration in a Response to a Final Action under 37 CFR § 1.116, with a statement that Applicant did not submit the declaration sooner since the commonly assigned art was first cited in a final rejection constitutes good and sufficient reason why the evidence is necessary and was not earlier presented, as provided for in 37 CFR § 1.116(e).

Conclusion

The statement under 35 U.S.C. § 103(c) and remarks presented herein are responsive to the new grounds of rejection, and therefore, could not have been presented earlier. For at least the foregoing reasons, all pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that would prevent allowance of this application, **Applicant requests that the Examiner contact the undersigned representative before issuing a subsequent Action.**

Respectfully Submitted,

Lee & Hayes, PLLC
Representatives for Applicant

By: /Bea Koempel-Thomas 58213/ Dated: September 10, 2010

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